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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,883

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Joseph J. Kubler

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EXAMINER

PEZZLO, JOHN

ART UNIT

PAPER NUMBER

2419

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10/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,883	Applicant(s) KUBLER ET AL.	
	Examiner John Pezzlo	Art Unit 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-127 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-64, 67-102, 105-117 and 120-127 is/are rejected.
- 7) ☒ Claim(s) 65, 66, 103, 104, 118 and 119 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/08, 7/21/08, 8/23/07, 11/16/06, 10/23/06, 6/23/06, 5/8/06/</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

I. Claims 22-53, 55, 56, 68-97, 105, and 120 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1. Regarding claims 22, 55, 68, 83, 105, and 120 – The examiner could not find support in the specification for "the at least one processor capable of prompting a user of the first telephony device for a packet network address corresponding to the second telephony device, if it is determined that a packet network address corresponding to the information identifying the second telephony device is not available". If the applicant can find support in the specification the examiner will withdraw the rejection.

Art Unit: 2419

2. Regarding claims 40-53 - The examiner could not find support in the specification for "A machine-readable storage, having stored thereon a computer program having a plurality of code sections for communicatively coupling a first telephony device and a second telephony device via a packet network, the code sections executable by a machine for causing the machine to perform the operations comprising". If the applicant can find support in the specification the examiner will withdraw the rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 54, 57-64, 67, 98-102, 106-117, and 121-127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Focaneanu et al. (US 5,610,910) hereinafter Focaneanu.

1. Regarding claim 54 – Focaneanu does not explicitly disclose receiving, from the first telephony device, information identifying the second telephony device, determining whether a packet network address corresponding to the second telephony device is available, sending, to the packet network address corresponding to the second telephony device, a call setup request, if it is determined that a packet network address corresponding to the second telephony device is

Art Unit: 2419

available, receiving, from the packet network address corresponding to the second telephony device, status information for the second telephony device, and notifying a user of the first telephony device of a busy condition, if status information indicating a busy condition is received.

Focaneanu discloses connecting customer premise equipment (CPE) such as a conventional telephone to a data network (the Internet) via an access network and a modem. Focaneanu discloses an access module which contains a database of user information such as a translation table for converting a telephone number into a packet network address (Internet address). Focaneanu discloses the system and hardware and software used to connect telephones via a packet network using telephone numbers and packet network address. Focaneanu discloses providing status information in order to complete the connections between telephones. Refer to Figures 3, 7, and 8 and column 2 line 58 to column 3 lines 15 and column 7 line 10 to column 9 line 5 and column 9 lines 30 to 40 and column 11 lines 60 to 65.

At the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Focaneanu with receiving, from the first telephony device, information identifying the second telephony device, determining whether a packet network address corresponding to the second telephony device is available, sending, to the packet network address corresponding to the second telephony device, a call setup request, if it is determined that a packet network address corresponding to the second telephony device is available, receiving, from the packet network address corresponding to the second telephony device, status information for the second telephony device, and notifying a user of the first telephony device of a busy condition, if status information indicating a busy condition is received.

Art Unit: 2419

The suggestion/motivation for doing so is that Focaneanu discloses the equipment and capabilities to set-up call between telephones over packet networks and convert between telephone numbers and packet addresses, refer to column 1 lines 7 to 13. The benefit being that more diverse networks and capabilities will be offered to the user extending telecommunications into new areas.

2. Regarding claims 98 and 113 – Focaneanu does not explicitly disclose information identifying a second telephony device, and information to cause the communication system to, at least, send a call setup request to a packet network address corresponding to the second telephony device, if the packet network address is available to the communication system.

Focaneanu discloses connecting customer premise equipment (CPE) such as a conventional telephone to a data network (the Internet) via an access network and a modem. Focaneanu discloses an access module which contains a database of user information such as a translation table for converting a telephone number into a packet network address (Internet address). Focaneanu discloses the system and hardware and software used to connect telephones via a packet network using telephone numbers and packet network address. Refer to Figures 3, 7, and 8 and column 2 line 58 to column 3 lines 15 and column 7 line 10 to column 9 line 5.

At the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Focaneanu with information identifying a second telephony device, and information to cause the communication system to, at least, send a call setup request to a packet network address corresponding to the second telephony device, if the packet network address is available to the communication system.

Art Unit: 2419

The suggestion/motivation for doing so is that Focaneanu discloses the equipment and capabilities to set-up call between telephones over packet networks and convert between telephone numbers and packet addresses, refer to column 1 lines 7 to 13. The benefit being that more diverse networks and capabilities will be offered to the user extending telecommunications into new areas.

3. Regarding claims 99 and 114 – Focaneanu does not explicitly disclose receive status information for the second telephony device from the packet network address corresponding to the second telephony device.

Focaneanu discloses connecting customer premise equipment (CPE) such as a conventional telephone to a data network (the Internet) via an access network and a modem. Focaneanu discloses an access module which contains a database of user information such as a translation table for converting a telephone number into a packet network address (Internet address). Focaneanu discloses the system and hardware and software used to connect telephones via a packet network using telephone numbers and packet network address. Focaneanu discloses providing status information in order to complete the connections between telephones. Refer to Figures 3, 7, and 8 and column 2 line 58 to column 3 lines 15 and column 7 line 10 to column 9 line 5 and column 9 lines 30 to 40 and column 11 lines 60 to 65.

At the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Focaneanu with receive status information for the second telephony device from the packet network address corresponding to the second telephony device.

Art Unit: 2419

The suggestion/motivation for doing so is that Focaneanu discloses the equipment and capabilities to set-up call between telephones over packet networks and convert between telephone numbers and packet addresses, refer to column 1 lines 7 to 13. The benefit being that more diverse networks and capabilities will be offered to the user extending telecommunications into new areas.

4. Regarding claim 100 and 115 – Focaneanu does not explicitly disclose establishing voice communication with the second telephony device via the communication system, if status information indicating acceptance of the call setup request is received by at least the communication system.

Focaneanu discloses connecting customer premise equipment (CPE) such as a conventional telephone to a data network (the Internet) via an access network and a modem. Focaneanu discloses an access module which contains a database of user information such as a translation table for converting a telephone number into a packet network address (Internet address). Focaneanu discloses the system and hardware and software used to connect telephones via a packet network using telephone numbers and packet network address. Focaneanu discloses providing status information in order to complete the connections between telephones. Refer to Figures 3, 7, and 8 and column 2 line 58 to column 3 lines 15 and column 7 line 10 to column 9 line 5 and column 9 lines 30 to 40 and column 11 lines 60 to 65.

At the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Focaneanu with establishing voice communication with the second telephony

Art Unit: 2419

device via the communication system, if status information indicating acceptance of the call setup request is received by at least the communication system.

The suggestion/motivation for doing so is that Focaneanu discloses the equipment and capabilities to set-up call between telephones over packet networks and convert between telephone numbers and packet addresses, refer to column 1 lines 7 to 13. The benefit being that more diverse networks and capabilities will be offered to the user extending telecommunications into new areas.

5. Regarding claims 63, 101, and 116 – Focaneanu does not explicitly disclose transmitting voice packets comprising digitized voice information and receiving voice packets comprising digitized voice information.

Focaneanu discloses connecting customer premise equipment (CPE) such as a conventional telephone to a data network (the Internet) via an access network and a modem. Focaneanu discloses an access module which contains a database of user information such as a translation table for converting a telephone number into a packet network address (Internet address). Focaneanu discloses the system and hardware and software used to connect telephones via a packet network using telephone numbers and packet network address. Focaneanu discloses providing status information in order to complete the connections between telephones. Refer to Figures 3, 7, and 8 and column 2 line 58 to column 3 lines 15 and column 7 line 10 to column 9 line 5 and column 9 lines 30 to 40 and column 11 lines 60 to 65.

Art Unit: 2419

At the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Focaneanu with transmitting voice packets comprising digitized voice information and receiving voice packets comprising digitized voice information.

The suggestion/motivation for doing so is that Focaneanu discloses connecting conventional telephones over packet networks and providing analog to digital conversion, refer to column 9 lines 40-50. The benefit being that more diverse networks can be interconnected offering more capabilities and services to the user.

6. Regarding claims 64, 102, and 117 – Focaneanu discloses communicating digitized voice information using modem signals, refer to Figure 3 and column 2 line 59 to column 3 line 15.

7. Regarding claims 57, 58, 106, 107, 121, and 122 – Focaneanu discloses telephony device is a conventional telephone, refer to Figure 1 and column 1 lines 18 to 60 and column 9 lines 40 to 60.

8. Regarding claims 60, 109, and 124 – Focaneanu discloses comparing the information identifying the second telephony device to at least one entry in a table, the at least one entry comprising information identifying a telephony device and a corresponding packet network address, refer to Figure 8 and column 8 lines 11 to 45.

Art Unit: 2419

9. Regarding claims 61, 110, and 125 – Focaneanu discloses the packet network address comprises an Internet protocol (IP) address, refer to Figure 1 and column 1 lines 18 to 60 and column 13 line 60 to column 14 line 12.

10. Regarding claims 62, 111, and 126 – Focaneanu disclose the packet network is the Internet, refer to Figures 1 and 3 and column 1 lines 18 to 60 and column 2 line 59 to column 3 line 15.

11. Regarding claims 112 and 127 – Focaneanu does not explicitly disclose notify the telephony device of a busy condition, if the received status information indicates a busy condition.

Focaneanu discloses connecting customer premise equipment (CPE) such as a conventional telephone to a data network (the Internet) via an access network and a modem. Focaneanu discloses an access module which contains a database of user information such as a translation table for converting a telephone number into a packet network address (Internet address). Focaneanu discloses the system and hardware and software used to connect telephones via a packet network using telephone numbers and packet network address. Focaneanu discloses providing status information in order to complete the connections between telephones. Refer to Figures 3, 7, and 8 and column 2 line 58 to column 3 lines 15 and column 7 line 10 to column 9 line 5 and column 9 lines 30 to 40 and column 11 lines 60 to 65.

Art Unit: 2419

At the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Focaneanu with notify the telephony device of a busy condition, if the received status information indicates a busy condition.

The suggestion/motivation for doing so is that Focaneanu discloses the equipment and capabilities to provide set-up call procedures between telephones over packet networks and convert between telephone numbers and packet addresses, refer to column 1 lines 7 to 13 and Figure 4 and column 5 lines 48 to 67. Providing a busy indication is part of the call set-up if the called party is off-hook. The benefit being that more diverse networks and capabilities will be offered to the user extending telecommunications into new areas.

12. Regarding claims 59 and 123 – Focaneanu discloses a conventional telephone number, refer to Figure 4 and column 5 lines 46 to 65.

13. Regarding claim 67 – Focaneanu discloses transmitting, to the first telephony device, at least one of a tone (DTMF signal) and prerecorded speech, refer to column 9 line 40 to column 10 line 16.

Allowable Subject Matter

Claims 65, 66, 105, 106, 118, and 119 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

1. Tisdale et al. (US 5,850,602) discloses a communication protocol for mobile earth terminal communication device used in mobile satellite communication system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Pezzlo whose telephone number is (571) 272-3090. The examiner can normally be reached on Monday to Friday from 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C.

or faxed to:

(571) 273-8300

For informal or draft communications, please label "PROPOSED" or "DRAFT"

Art Unit: 2419

Hand delivered responses should be brought to:

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2A15

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Alexandria, VA, 22313.

John Pezzlo

26 October 2008

/John Pezzlo/

Primary Examiner, Art Unit 2419